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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,912	05/04/2001	Roy Cohen	COHEN-001	7127

7590  
Charles Bickoff  
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Sharon, MA 02067

04/11/2003

EXAMINER

SEVER, ANDREW T

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/848,912

Applicant(s)

COHEN, ROY

Examiner

Andrew T Sever

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 is/are allowed.
- 6) ☒ Claim(s) 1-5,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 1 and 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 42 and 45. **A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.**

### *Claim Objections*

2. Claim1 objected to because of the following informalities: spelling errors. Appropriate correction is required.

In the last line of claim rearward is spelled “reward”. Appropriate correction is required.

Although the examiner did not note any other instances of errors, the examiner request that the applicant carefully review the claims to insure that no other such errors are present and make appropriate corrections when necessary.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mastnak (US 5,444,263.)

Mastnak teaches in figure 4 a counterfeit detection device for magnifying and observing the detailed security features of a document having at least one security feature such as a 10 dollar bill (a type of bank note which Mastnak teaches in column 1 line 5-10, Mastnak's invention is for authenticating and which the present applicant acknowledges has more than one security features in applicant's figures 1a and 1b.) Mastnak's device comprises an omni-directional magnification lens (rod lens 2, which those skilled in the art would recognize is an elongated spherical lens with a planar bottom, the top curved part comprises the first surface and the bottom planar portion comprises a second surface.) An object plane (10) for placing a document (such as the before mentioned bank note) is located inherently in the object plane of the before mentioned lens (2). A light source (4) is located distal to the document/object plane (10) in such a way that it illuminates from a rearward side the document so that it is useful for viewing watermarks, micro printing, internal polyester threads and the like. The light source is connected to a power source (batteries contained in compartment 11). A power supply-connecting switch (5) is located between the power source (11) and the light source (4) as is claimed by applicant's claim 4. Mastnak teaches in column 2 lines 50-54 that the light source (4) can either be a broad-spectrum visible light source or an ultraviolet light source as is claimed by applicant's claim 5.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastnak (US 5,444,263 as applied to claims 1, 4, and 5 above, and further in view of Someya (US 4,381,892.)

As described in more detail above, Mastnak teaches a counterfeit detection device for magnifying and observing the detailed security features of a document (such as a ten dollar bill) having at least one security feature wherein. Mastnak teaches a device having an omni-directional magnification lens having two surfaces one which is curved and the other planar. The document to be examined is placed proximately at the object plane of the lens. A light source is located distal to the document such that it illuminates the rearward side of the document. The light source is powered by batteries and is connected to a switch. The light source optionally can be a UV light source.

Mastnak, however, does not teach surrounding the magnification lens by an ambient light-blocking shroud. This however is very well known in the magnification/optical arts, for example viewfinders with magnifiers in them for cameras such as taught by Someya in figure 1 frequently include light blocking shrouds. Other examples can be cited such as common binoculars, microscope eyepieces, telescope eyepieces, and numerous other optical magnification systems where ambient light is not

beneficial. Since the addition of a light blocking shroud is so well known and common when using a magnification lens, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an ambient light blocking shroud on Mastnak's counterfeit detection device.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastnak (US 5,444,263 as applied to claims 1, 4, and 5 above, and further in view of Hayano et al. (US 5,072,128) and Tichenor et al. (US 5,243,405.)

As described in more detail above, Mastnak teaches a counterfeit detection device for magnifying and observing the detailed security features of a document (such as a ten dollar bill) having at least one security feature wherein. Mastnak teaches a device having an omnidirectional magnification lens having two surfaces one which is curved and the other planar. The document to be examined is placed proximately at the object plane of the lens. A light source is located distal to the document such that it illuminates the rearward side of the document. The light source is powered by batteries and is connected to a switch. The light source optionally can be a UV light source.

Mastnak, however, does not teach that the first surface of the lens is spherical rather Mastnak teaches a singular lens that has a first surface that is cylindrical. It is well known in the optical arts to use largely spherical lens in exchange of spherical lens, such as is taught by Hayano et al. in column 13 lines 60-65. Tichenor et al. teaches an optical system for surface verification which can be used for counterfeit detection that uses both a cylindrical lens (26) and a spherical lens (24). Given that both lens types are used commonly either interchangeably or in

combination it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lens in Mastnak's counterfeit detection device have a first surface that is largely spherical or to supply a second lens to Mastnak's counterfeit detection device that is has a spherical first surface and a planer second surface.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastnak (US 5,444,263 as applied to claims 1, 4, and 5 above.

As described in more detail above, Mastnak teaches a counterfeit detection device for magnifying and observing the detailed security features of a document (such as a ten dollar bill) having at least one security feature wherein. Mastnak teaches a device having an omni-directional magnification lens having two surfaces one which is curved and the other planar. The document to be examined is placed proximately at the object plane of the lens. A light source is located distal to the document such that it illuminates the rearward side of the document. The light source is powered by batteries and is connected to a switch. The light source optionally can be a UV light source. It is well known that UV light is harmful to the eye and direct viewing of it can damage the eye as well as over time cause the formation of harmful defects in the lens of the eye. Although Mastnak does not teach a UV filter as part of the lens, it would be obvious to one of ordinary skill in the art to include one as UV filters are relatively cheap, are commonly added to lens (such as eye glasses) and protecting the user of the counterfeit detection device from harmful UV rays is important. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an ultraviolet filter proximate to the second surface of the lens taught by Mastnak.

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9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastnak (US 5,444,263 as applied to claims 1, 4, and 5 above, and further in view of Backer et al. (US 2,059,197.)

As described in more detail above, Mastnak teaches a counterfeit detection device for magnifying and observing the detailed security features of a document (such as a ten dollar bill) having at least one security feature wherein. Mastnak teaches a device having an omni-directional magnification lens having two surfaces one which is curved and the other planar. The document to be examined is placed proximately at the object plane of the lens. A light source is located distal to the document such that it illuminates the rearward side of the document. The light source is powered by batteries and is connected to a switch. The light source optionally can be a UV light source.

Mastnak does not teach that the magnifying lens is a zoom lens for magnifying the document with variable magnification. Backer et al. teaches a counterfeit paper money detector that includes a lens system that includes a movable lens (6 in figure 1) which can be moved towards and away from the document for zooming in or out from the document to produce variable magnification depending on the size of the detail/security feature being examined. The increased magnification is taught to be used for such things as counting the number of threads in the paper of the document, whereas at lower magnifications looking at what is actually printed. Since thread counts are an important part of counterfeit detection (the type of linen a bill is printed on is specific to its denomination, country of origin, and so forth) it would be obvious to one of ordinary skill in the art at the time the invention was made to include a zooming function



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in the lens of Mastnak's counterfeit detection device as taught by Backer et al. so that both small and large details can be analyzed to determine if a bank note is genuine or not.

*Allowable Subject Matter*

10. Claims 11-19 are allowed.

11. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

Claims 6-8 claim a reflective mirror, which is located between the document and the magnification lens for reflecting the light from the illumination source, which is behind the document onto the front of the document. This was not found in the prior art. Although the prior art teaches placing the light source above the document and directly shining the light onto the front of the document with or without a light beneath the document (such as taught by Backer et al. in figure 3), the prior art does not teach using a mirror to reflect light from a light source disposed beneath the document onto the front of the document. Some prior art references allude to the document examination chambers being reflective, however this also does not read on the claimed invention, since in these cases the light sources were also disposed above the document and the reflective surfaces were only present to amplify the light reflecting off the document. Since the prior art of record did not reveal a mirror located between the document and the

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magnification lens and no reasonable combination of the prior art of record would obtain the claimed invention claims 6-8 would be allowable if written in independent form including the claimed subject matter of claims 5 and 1 of which they are dependent on.

Independent claim 11 claims the matter of rejected claim 1, plus the additional feature that the lens shroud and lens are pivotal, so that the lens shroud and lens can be pivoted away from the counterfeit detect device, so that an user can directly view the document for viewing such features as watermarks and the like unmagnified with the document. This is shown in figure 8 of applicant's drawings. The only prior art device that would possibly have a function like this is that of Mastnak, however, Mastnak clearly does not teach a method of removing the lens from the counterfeit detection device. Further in similar related viewing devices with magnifiers such as cameras with shrouded viewfinders; a breakaway shroud and magnifier is not well known and it would not necessarily be obvious to combine one with Mastnak to produce a counterfeit detection device that functions in the manner shown in figure 8 of applicant's drawings. Since the prior art or record does not teach such a pivotal feature, claim 11 is allowed. Claims 12-19 are dependent on claim 11 and are therefore also allowed.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,874,742 to Romano, teaches a counterfeit detection viewer that has a UV light source which is above the document and a lens that is above both the light source and document.

US 6,470,093 to Liang, teaches a portable counterfeit detection device which includes both a UV and a visible light source placed underneath the document. A lens is placed above the document. A mirror can be used to reflect an image of a proof onto a document that is being examined.

US 2,161,594 to J. H. Ruth

US 3,774,046 to Hoch et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Sever whose telephone number is 703-305-4036. The examiner can normally be reached M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Adams can be reached at 703-308-2847. The fax phone numbers for the


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organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

AS

April 4, 2003



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